

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Charles E. Rogler et al.

Application No.: 10/805,653

Confirmation No.: 9589

Filed: March 19, 2004

Art Unit: 1632

For: **CHRONIC HEPATITIS VIRUS INFECTION
AND CLONAL HEPATOCELLULAR
CARCINOMA IN MOUSE REPOPULATED
LIVERS**

Examiner: Michael C. Wilson

**STATEMENT ESTABLISHING UNINTENTIONAL DELAY TO REPLY TO OFFICE
ACTION MAILED OCTOBER 6, 2006**

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Statement is submitted in conjunction with the accompanying Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. 1.137(b) and sets forth facts establishing that the entire delay in filing a response to an Office Action for the above-identified application that was mailed on October 6, 2006 ("the Oct. 6 Office Action") until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

Patent application no. 10/805,653 ("the '653 application") was filed on March 19, 2004 as a continuation of application no. 09/344,189, filed June 24, 1999, now U.S. Patent No. 6,864,402, which is a continuation-in-part of application no. 09/156,892, filed September 18, 1998, now abandoned. Dr. Charles E. Rogler ("Rogler") and Dr. Joerg Petersen ("Petersen") are the named co-inventors of the '653 application.

Rogler and Petersen assigned their respective rights to the application to Albert Einstein College of Medicine of Yeshiva University, a division of Yeshiva University ("Albert Einstein"), in assignments recorded at the USPTO respectively on September 2, 1999 at reel

010212 frame 0245 and on March 21, 2001 at reel 012259 frame 0303. Rogler was the contact person for and controlled prosecution of the prior applications, with the knowledge and consent of Albert Einstein. Patent counsel communicated with Rogler concerning the prior applications and looked to Rogler for instructions concerning their prosecution.

The Oct. 6 Office Action for the '653 application was received by counsel and reported to Rogler and Albert Einstein on October 17, 2006. Albert Einstein confirmed that counsel should look to Rogler for instructions concerning filing a response to the Oct. 6 Office Action, and that if Rogler elected not to file a response Albert Einstein would permit the application to become abandoned. Albert Einstein did not instruct counsel to seek instructions from Petersen. Counsel was under the impression that Rogler would confer with Petersen about responding to the Office Action. Counsel did not receive instructions from Rogler regarding a reply to the Oct. 6 Office Action and no response was filed within the extended reply deadline of April 6, 2007.

On May 29, 2007, Rogler contacted Petersen and advised that an Office Action had been received for the '653 application, that no response to the Office Action had been filed, and that the '653 application had been abandoned. Petersen advised Rogler that it was not his intention to abandon the '653 application and requested that action be taken to revive the application. Rogler instructed the undersigned attorneys to determine whether the application could be revived on June 5, 2007. The time between June 5, 2007 and the filing of the present Petition was used to establish the facts surrounding the failure to timely reply to the Oct. 6 Office Action, establish that grounds existed for filing the present Petition, and attend to preparation of the Petition and a reply to the Oct. 6 Office Action to be filed with the Petition.

It is respectfully submitted that the facts set forth above establish that the failure to file a reply to the Oct. 6 Office Action was unintentional and that the entire delay in filing a reply to the Oct. 6 Office Action, from the due date for such a reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. Prompt and favorable consideration of the attached Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. 1.137(b) is requested.

Dated: September 25, 2007

Respectfully submitted,

By 

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